

REMARKS/ARGUMENTS

Favorable reconsideration of this application in light of the following discussion, is respectfully requested.

Claims 37-40, 48-51, 59-62, and 97-106 are pending in the present application.

In the outstanding Office Action, Claims 37-40, 48-51, 59-62, and 97-106 were rejected under 37 CFR §1.112, first paragraph; Claims 37-40, 48-51, 59-62, and 97-106 were rejected under 35 U.S.C. §112, second paragraph; Claims 37-39, 48-50, 59-61, and 97-106 were rejected under 35 U.S.C. §102(b) as anticipated by Griebenow et al. (U.S. Patent No. 5,850,520, hereinafter Griebenow); and Claims 40, 51, and 62 were rejected under 35 U.S.C. §103(a) as unpatentable over Griebenow in view of Logan et al. (U.S. Patent No. 5,721,827, hereinafter Logan).

Applicant respectfully traverses the rejection under 35 U.S.C. §112, first paragraph. Applicant respectfully submits that the pending claims comply with the written description requirement.

With respect to the written description requirement, there is no *in haec verba* requirement, and claim limitations may be supported by the specification through ***express, implicit, or inherent*** disclosure.¹ To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention.²

If a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met. See, e.g., *Vas-Cath*, 935 F.2d at 1563, 19 USPQ2d at 1116; *Martin v. Johnson*, 454 F.2d 746, 751, 172

¹ MPEP §2163.

² *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555 (Fed. Cir. 1991).

USPQ 391, 395 (CCPA 1972) (*stating "the description need not be in ipsius verbis [i.e., "in the same words"] to be sufficient"*).

Thus, the exact phrase "self-distributed by a user of the personal computer" not appearing in the specification is an insufficient basis for concluding lack of written description.

The analysis of whether the specification complies with the written description "is conducted from the standpoint of one of skill in the art. Generally, there is an inverse correlation between the level of skill and knowledge in the art and the specificity of disclosure necessary to satisfy the written description requirement."³

Moreover, the MPEP discusses several factors that must be considered in order to make a 112, first paragraph, rejection for lack of written description. The MPEP states:

Whether the specification shows that applicant was in possession of the claimed invention is not a single, simple determination, but rather is a factual determination reached by considering a number of factors. Factors to be considered in determining whether there is sufficient evidence of possession include the level of skill and knowledge in the art, partial structure, physical and/or chemical properties, functional characteristics alone or coupled with a known or disclosed correlation between structure and function, and the method of making the claimed invention.

* * * *

The description needed to satisfy the requirements of 35 U.S.C. 112 "varies with the nature and scope of the invention at issue, and with the scientific and technologic knowledge already in existence." *Capon v. Eshhar*, 418 F.3d at 1357, 76 USPQ2d at 1084.

* * * *

Thus, an inventor is not required to describe every detail of his invention. An applicant's disclosure obligation varies according to the art to which the invention pertains. Disclosing a microprocessor capable of performing certain

³ Page A-7 of the USPTO's *Written Description Training Materials*, revision 1, March 25, 2008.

functions is sufficient to satisfy the requirement of section 112, first paragraph, when one skilled in the relevant art would understand what is intended and know how to carry it out."⁴

The outstanding Office Action fails to provide any explicit analysis as to the above-noted factors, which are pertinent to a determination of compliance with the written description requirement. Thus, the outstanding Office Action has failed to set forth a *prima facie* case of failing to comply with the written description requirement.

Furthermore, “self-distributed by a user of the personal computer” is supported by the discussion of the “personal casting” beginning on page 22 of the originally filed specification. More particularly, page 24 of the originally filed specification describes capturing video data, the bottom of page 25 of the originally filed specification describes that the user edits a movie, and the content is uploaded (button 27 in Fig. 4), which is how the content creator self-distributes the content (i.e., the content creator distributes the content).

Thus, a person of ordinary skill in the art would recognize that the inventor was in possession of the claimed invention at the time of filing and the written description requirement is satisfied. The rejection under 35 U.S.C. §112, first paragraph, should be withdrawn.

With respect to the rejection under 35 U.S.C. §112, second paragraph, this rejection is respectfully traversed. With respect to “self-distributing,” Applicants respectfully submit that this claim element “clearly describes and distinctly claims the subject matter which applicants regard as the invention.” As noted above, a person of ordinary skill in the art would understand “self-distributing” in the context of the specification and the above-noted “personal casting” embodiment of the application.

With respect to the “predetermined information separate from the content data” of Claim 48, MPEP §2173.04 states that breadth is not indefiniteness. Furthermore, Fig. 14 of

⁴ MPEP §2163, emphasis added.

the Application shows genre setup 85A. As explained on page 26 of the originally filed specification, the content created by the user is uploaded, and control screen 75 is displayed. Upon selecting option button 81, the menu 85 is displayed which allows the user (content creator) to proceed with genre setup. Thus, the content is uploaded separately from the “predetermined information...including at least category information defining a genre of the content data.”⁵

Thus, Applicants respectfully submit that the pending claims comply with the requirements of 35 U.S.C. §112, second paragraph, and request that this ground of rejection be withdrawn.

With respect to the rejection of Claim 37 as anticipated over Griebenow, Applicants respectfully traverse this ground of rejection. Claim 37 recites, *inter alia*,

first receiving means for receiving from a personal computer via internet, ***content data self-distributed by a user of the personal computer***, and predetermined information, separate from the content data, including at least category information defining a genre of the content data; [and]

means for ***changing the information defining genre of the content data to a different genre, through the personal computer after receiving the predetermined information.***

Griebenow does not disclose or suggest every element of amended Claim 37.

With respect to the changing of the information defining genre, page 3 of the Office Action refers to col. 7, lines 33-66 of Griebenow. However, this section of Griebenow merely describes a consumer ordering an electronic magazine regarding bicycling. This is not “means for ***changing the information defining genre of the content data to a different genre, through the personal computer after receiving the predetermined information.***”

⁵ See Claim 48.

In the invention defined by Claim 37, it is the genre of the content data self-distributed by the user of the personal computer that is changed. Selecting an electronic magazine about bicycling does not change the genre of the underlying content. Claim 37 specifically states “changing information *defining* genre of *the content data to a different genre*.” For example, the content self-distributed by the user of the personal computer may initially be indicated to have a genre of sports. The genre of the content self-distributed by the user of the personal computer can be changed to cars, for example. Thus, the genre associated with the underlying content is changed.

In view of the above-noted distinctions, Applicants respectfully submit that Claim 37 (and any claims dependent thereon) patentably distinguish over Griebenow. Claims 48, 59, and 97 recite elements analogous to those of Claim 37. Thus, Claims 48, 59, and 97 (and any claims dependent thereon) patentably distinguish over Griebenow for at least the reasons stated for Claim 37.

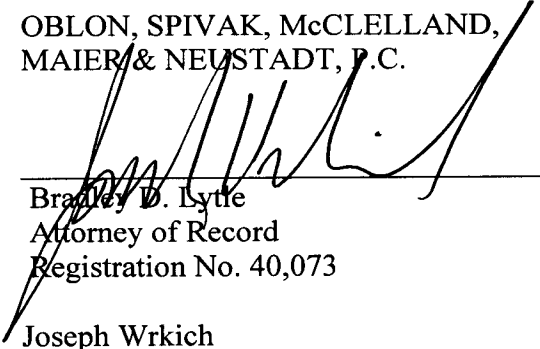
Moreover, Claims 99-102 further patentably distinguish over Griebenow. It is noted that the outstanding Office Action fails to specifically address the elements of Claims 99-102. This is in violation of 37 CFR §1.104(b), which requires that examiner’s action be complete as to all matters. Thus, the Office Action is deficient and must be withdrawn.

Page 3 of the Office Action equates the claimed “predetermined information” as being the bicycling at col. 7, lines 39-41 of Griebenow. However, there is no disclosure or suggestion of this section of Griebenow (or elsewhere) of “the predetermined information includes data, provided by the personal computer, that indicates whether the commercial will be reproduced in conjunction with the reproduction of the content data,” as recited in Claim 99-102. Thus, Claims 99-102 further patentably distinguish over Griebenow.

Consequently, in light of the above discussion and in view of the present amendment, the present application is believed to be in condition for allowance and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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